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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,176	02/09/2004	Shaun T. Mesher	355-8	6755
20212	7590	04/01/2011		
Lambert Intellectual Property Law Suite 200 10328 - 81 Avenue Edmonton, AB T6E 1X2 CANADA			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1762	PAPER NUMBER
			NOTIFICATION DATE 04/01/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/773,176

Applicant(s)

MESHER ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10, 14, 16-17, 30-41, 43 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 14, 16-17, 30-41, 43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 10, 14, 16-17, 30-41, 43 and 45-47 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 August 2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 10, 30-41, 43 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 sets forth intermediate transitional language (*e.g.*, "consisting essentially of") followed by open transitional language (*e.g.*, "comprising"). Applicants' intended scope of the claim is indefinite.

Claim 43 is indefinite regarding what solvent is intended by "the solvent" since most and/or all the recited components of claim 1 may function as solvents.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 10, 14, 16-17, 30-41, 43 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins, US 4,737,296, in view of Munoz, Jr. et al, US PGPUB 20030078180, and Jennings, Jr., US 4,807,703.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1; column 9, lines 45) discloses the formation of acid-containing foams for the purpose of cleaning scale out of conduits. Watkins (column 7, line 36) clearly contemplates mixtures of solvents.

Watkins (column 8, lines 6 et seq) clearly contemplates alcohols, esters and ketones as claimed.

Watkins differs from the claims in the use of a particular combination of solvents, the further use of a cyclic ether, e.g., tetrahydrofuran and the concentrations thereof.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1) contemplates mixtures of solvents including those instantly claimed. Watkins (example 16) discloses the use of MEK at about 22 vol% and about 74 vol% acid. The vol% is referenced for simplicity and the wt% of the materials would not vary

dramatically therefrom since the materials would have been expected to have specific gravities of about 1.

Munoz, Jr. et al discloses aqueous acid foaming compositions comprising (paragraph [0032] and claim 8) mutual solvents including alcohols, esters, ketones (e.g., MEK) and cyclic ethers (e.g., THF) at concentrations of 1 to 50 wt % of the foamer composition. Munoz, Jr. et al further teaches solvent combinations.

Jennings, Jr (abstract and column 1, lines 1 et seq; column 3, lines 9-36) discloses foamable acid treating compositions comprising alcohols, esters, ketones (e.g., MEK) and cyclic ethers (e.g., THF).

It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, the ester, ether, and alcohol solvents are all taught for the same function as a mutual solvent of the oil and water. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the mixtures in an acid-containing composition for the advantage of matching the solvent system to the system, e.g., sludge and scale, being treated.

The specification does not provide a showing of criticality of the particular solvents and each is specifically recited in the Watkins, Munoz, Jr. et al, and Jennings, Jr references.

Since Watkins (column 8, lines 6 et seq) clearly contemplates the instantly claimed alcohols, esters and ketones in various concentrations and the properties of said solvents are well known, it is reasonable and would have been obvious to the ordinary skilled artisan to employ the solvents in mixtures at varied concentrations in the absence of unobvious and/or criticality of the particular concentrations.

6. Claims 1, 10, 30-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slusser, US 3,915,233 (Slusser (I)), in view of Slusser et al, US 3,131,759 (Slusser et al (II)).

Slusser (I) (abstract and 2:20¹ et seq) is directed to acidizing and the desirable use (4:14 et seq, particularly 4:29, 47, 62 and 66) of mutual solvents including methyl alcohol, dioxane, methylacetate and methyl ethyl ketone. Slusser et al (II) is referenced in Slusser (I) (4:6-8) regarding solvents and Slusser et al (II) further teaches solubility considerations.

It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re

¹ Corresponds to column 2, lines 20 et seq.

Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, the ester, ketone, and alcohol solvents are all taught for the same function as a mutual solvent of the oil and water acidizing processes. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the mixtures in an acid-containing composition for the advantage of matching the solvent system to the system to be treated, *e.g.*, sludge and scale, being treated.

Response to Arguments

7. Applicants' arguments filed 25 August 2010 have been fully considered but they are not persuasive.
8. Applicants (pages 7 and 8) assert that paragraph [0012] of the published application shows the required criticality for the claimed combination since samples that give complete oil separation/effervescence in 15 minutes or less is distinct from samples that take less than 15 minutes. This has not been deemed persuasive for the following reasons: (i) initially, it is not clear that applicants' test is a standard in the art and that the particular oil and time for separation is probative. (ii) Applicants' characterization that the single test shows unexpected results for the scope of the claims is not deemed persuasive. Attention is directed to MPEP 716, which discusses the requirements for a showing of unexpected results. (iii) Applicants' assertion is not consistent with the data in paragraph [0012] of the published application and said data is not commensurate in scope with the independent claims. Paragraph [0012] of the

published application shows the methanol / ethyl acetate combination, which is outside the claimed scope but is asserted by applicants to be inventive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Daniel S. Metzmaier/
Primary Examiner, Art Unit 1762**

DSM